

Applicants: Aidan J. Lavery et al.
Appl. No.: 10/785,290
Filed: February 23, 2004
page 7 of 10

REMARKS

Claims 2-12 and 14-15 were pending in the subject application. By this amendment, Claim 2 has been amended and new Claims 16 and 17 have been added. Accordingly, upon entry of this amendment, Claims 2-12 and 14-17 will be pending.

Applicants maintain that the amendments to the claims do not raise an issue of new matter. Support for new Claims 16 and 17 can be found at least in Claims 14 and 15. Support for the amendment to Claim 2 can be found at least in the previous version of the claim. Accordingly, entry of the amendments is respectfully requested.

Interview Summary

Applicants thank the Examiner for the courtesy of a telephone interview on August 17, 2007 with the undersigned attorney. During the interview, the rejections of the claims set forth in the July 9, 2007 Office Action were discussed. The Examiner indicated that the rejection under 35 U.S.C. §112, first paragraph, has been withdrawn, but that the rejection under 35 U.S.C. §103(a) is maintained.

Rejections under 35 U.S.C. §112, First Paragraph

Claims 2-12, 14 and 15 were rejected as not complying with the written description requirement. The Examiner indicated in the Office Action that the specification did not provide support for the “ozone protective layer” recited in Claims 14 and 15.

Applicants understand that this rejection has been withdrawn.

Nevertheless, applicants would like to highlight the following support in the specification for the “ozone protective layer.” The application sets forth that “The object of the invention is thus to provide another recording material for the ink-jet printing

Applicants: Aidan J. Lavery et al.
Appl. No.: 10/785,290
Filed: February 23, 2004
page 8 of 10

method which has improved resistance to the action of ozone and at the same time has a high light fastness" (Summary of the Invention, paragraph [0024] on page 6). Working examples set forth in the application describe how the protective layer can be deposited on the dye-fixing layer. In paragraph [0027] on page 7, it is stated that "As a result of the formation of a complex of metal compound and sulphur-containing compounds in the presence of boric acid, a good light fastness and a very good ozone resistance can be achieved with this layer." (Emphasis added.) This result is clearly documented in Table 6 on page 23, which shows improved ozone resistance in examples having the protective layer. Paragraph [0081] on pages 23-24 discusses in detail the results shown in Table 6 for ozone resistance. The improved ozone resistance of the invention is also highlighted in the last sentence of the Abstract of Disclosure.

Rejections under 35 U.S.C. §103(a)

Claims 2-12, 14 and 15 are rejected as unpatentable over Ohbayashi et al. (US 6,492,005 B1) in view of Farooq et al. (US 6,703,112 B1).

Applicants maintain that the cited references do not teach or suggest the ozone protective layer set forth in Claims 14 and 15. Applicants' undersigned attorney understands that the Examiner's position as set forth during the August telephone interview is that an ozone protective layer would be inherent to the teachings of the cited references. In reply, applicants respectfully note that "[i]nherency and obviousness are distinct concepts. *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966)." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555, 220 USPQ 303, 314 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Furthermore, "the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is

Applicants: Aidan J. Lavery et al.
Appl. No.: 10/785,290
Filed: February 23, 2004
page 9 of 10

unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Finally, "[s]uch a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989)." *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

New Claims 16 and 17 require that the protective layer "consist essentially of" the recited components. Ohbayashi teaches an ink jet recording sheet comprising a support and an ink absorptive layer (Abstract). The ink absorptive layer can be formed of two or more ink absorptive layers (Column 17, lines 1-3). According to the Abstract and Summary of the Invention, the ink absorptive layer of Ohbayashi comprises dicyandiamide polycondensation products including polyalkylenepolyamine-dicyandiamide polycondensation product (Summary of the Invention) and formalin-dicyandiamide polycondensation product (Claim 1). Farooq teaches organometallic salts for inkjet receptor media (Abstract). Applicants maintain that the cited references do not teach or suggest a protective layer consisting essentially of the components set forth in Claims 16 and 17.

Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

Applicants: Aidan J. Lavery et al.
Appl. No.: 10/785,290
Filed: February 23, 2004
page 10 of 10

CONCLUSIONS

In view of the preceding amendments and remarks, applicants respectfully request that the Examiner reconsider and withdraw the rejections in the July 9, 2007 Office Action, and earnestly solicit allowance of the claims under examination. If there are any minor matters preventing allowance of the subject application, the Examiner is requested to telephone the undersigned attorney.

A check for \$260.00 is enclosed for the fees for filing 1 claim in addition to the number of claims previously paid for (\$50.00) and one independent claim in excess of three independent claims (\$210.00). No other fee is deemed necessary in connection with the submission of this Amendment. However, if any other fee is required with this reply or to maintain the pendency of the subject application, authorization is hereby given to withdraw the amount of any such fee from Deposit Account No. 01-1785. Any overpayments may be credited to Deposit Account No. 01-1785.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP
Attorneys for Applicants
90 Park Avenue
New York, New York 10016
(212) 336-8000

Dated: October 9, 2007
New York, New York

By _____


Alan D. Miller, Reg. No. 42,889